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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,475	07/01/2003	Akio Sugimoto	KOBE.0052	1029

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/609,475	SUGIMOTO ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *19-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 23-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1106,0416,0503*, 0107
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18 and 23-32, drawn to a foamed resin laminate sound insulation board, classified in class 428, subclass 319.1.

II. Claims 19-22, drawn to a method of making a foamed resin laminate sound insulation board, classified in class 264, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as extrusion instead of molding.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Stanley Fisher on 04/22/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18, and 23-32 . Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-22 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18, and 23-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble necessarily requires the presence of the foamed resin in the laminate while the phrase "at least unfoamed formable resin to be foamed at a foaming temperature by heating" indicates the resin is not necessarily foamed. This renders the claim indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 11, 12, 14, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Holtrop et al (US 4,557,970). Holtrop discloses a laminate structure comprising a foam layer 12, a foam layer 13 and a foam layer 14. The foam layer 14 having a thickness from 0.15 cm to 1.25 cm corresponds to Applicants' hard plate. The foam layer 12 and the foam layer 13 are made from chemically different resins to have different acoustical properties (column 3, lines 18-20). Likewise, the resins of the foam layers 12 and 13 would be foamed at different foaming temperatures and their melting temperatures are expected to be different. Holtrop teaches the laminate structure further comprising a thermoplastic film 21 attached to the foam layer 12 (figure 1). The foam layer 12 is made from a polyethylene resin (column 3, lines 30-35). Since Holtrop uses the same resin to form the foam layer as Applicants, it is not seen that the melting point of the resin would be outside the claimed range. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, Holtrop anticipates the claimed subject matter.

7. Claims 15-18, and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holtrop et al (US 4,557,970). Mixing the foaming agent, setting the foaming temperature are directed to product-by-process limitations. However, they are not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a foam layer/foam layer/hard plate or non-foam/ foam layer/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are

commensurate in scope with Holtrop. It is the examiner's position that Holtrop anticipates or strongly suggests the claimed subject matter.

8. Claims 1-7, 10-14, and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al (US 4,734,323). Sato discloses a laminate structure comprising a panel surface (hard plate) 1, an adhesive 20, a retainer layer 21 and a foam layer 23 (figure 6). Sato discloses a laminate structure comprising a plate 24, a foam layer 23 and a retainer layer 12 (figure 8). The retainer layer and the foam layer 23 are made from chemically different resins (example 5). The foam layer includes 1,2-polybutadiene having a melting point of 80oC while the retainer layer includes a thermosetting phenol resin which has a melting point much higher than the melting point of 1,2-polybutadiene (column 3, lines 15-17, column 4, lines 5-10). Likewise, the resins of the retainer layer and the foam layer would have different melting temperatures and foaming temperatures. Since Sato uses the same resin to form the foam layer as Applicants, it is not seen that the melting point of the resin would be outside the claimed range. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, Sato anticipates the claimed subject matter.
9. Claims 8, 9, 15-18, 23, 24 and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (US 4,734,323). Thermally fusion, mixing the foaming agent, setting the foaming temperature are directed to product-by-process limitations. However,

they are not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a foam layer/non-foam layer/hard plate or non-foam/ foam layer/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Sato. It is the examiner's position that Sato anticipates or strongly suggests the claimed subject matter.

10. Claims 1-6, 11, 12, 14, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1020846. Murakami et al (US 6,720,069) is relied on as an

equivalent form of EP 1020846. Murakami discloses a sound absorbing structure comprising two or more stacked layers of porous members (column 14, lines 48-52). The porous members correspond to Applicants' foam layer, non-foam layer and hard plate. The porous member is either a polyurethane foam or a molded fibrous material (claim 1). The porous members are made of different types of elastomer or rubber (column 16, lines 60-65). Likewise, the melting temperature and the foaming temperature are expectedly different. Murakami teaches the foam member having a film structure laminated on the surface of the foam member (column 8, lines 19-21). The foam member is made from a polyurethane resin (claim 1). Since Murakami uses the same resin to form the foam layer as Applicants, it is not seen that the melting point of the resin would be outside the claimed range. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, Murakami anticipates the claimed subject matter.

11. Claims 15-18, and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1020846. Murakami et al (US 6,720,069) is relied on as an equivalent form of EP 1020846. Mixing the foaming agent, setting the foaming temperature are directed to product-by-process limitations. However, they are not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the

method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a foam layer/foam layer/hard plate or non-foam/ foam layer/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Murakami. It is the examiner's position that Murakami anticipates or strongly suggests the claimed subject matter.

12. Claims 1, 2, 5-7, 11, 12, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Wycech (US 6,372,334). Wycech discloses a laminate structure comprising a metal substrate 1, a compliant foam layer 5, a rigid foam layer 6 and a backing film layer 7 (figure 5-7 and 9). Accordingly, Wycech anticipates the claimed subject matter.

13. Claims 8, 9, 15-18, 23, 24 and 30-32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wycech (US 6,372,334). The two foam layer thermally fused to each other, mixing the foaming agent, setting the foaming temperature are directed to product-by-process limitations. However, they are not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a foam layer/foam layer/hard plate or non-foam/ foam layer/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are

commensurate in scope with Wycech. It is the examiner's position that Wycech anticipates or strongly suggests the claimed subject matter.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

HAI VO
PRIMARY EXAMINER